

Remarks

Specification

Page 2 of the Office Action states that the disclosure is objected to because of the following informalities: "Page 1, paragraph 1 continues to make reference to the appended claims, which is improper in US Patent practice." It should be noted that, according to Applicant's file, a marked-up specification for this application was submitted to the USPTO on 02/19/2002, which included the following paragraph [0001]. Paragraph [0001] removed reference to the claims and added the features of the claims in place of that improper reference. It is respectfully requested that the Examiner ensure that the marked-up copy of specification previously submitted be properly acknowledged in the file. If the marked-up specification is missing from the file, Applicant will provide a replacement copy upon notice that it is not present in the file. For the Examiner's review, paragraph [0001] of the previously submitted marked-up specification was as follows:

[0001] The invention relates to a catheter [in accordance with the preamble of Claim 1 or 29] for the ablation of biological, in particular of animal or human, tissue, preferably for the ablation or mapping electrode, characterized in that the at least one ablation or mapping electrode has a reduced number of electrical interference centers that generate microscopic electric potential differences, field strength maxima or microscopically different reaction capabilities at the electrode surface, a method for treating catheters, and an apparatus for carrying out the treatment of catheters.

Drawings

Corrected drawings accompany this Amendment. The drawings include the statement "Replacement Pages", as required. Applicant respectfully believes that the Examiner's

objections were with Figures 3-15, and thus, they have been replaced. If the Examiner also objects to Figures 1 and 2, Applicant will provide replacement sheets for those Figures, also. Since these are merely clearer copies of the drawings, rather than changes to the drawings, no Letter to the Draftsperson of the USPTO is included herewith.

Rejection Under 35 USC 102

Claim 1, 2, 4, 6-9, 26 and 28-31 are rejected under 35 USC 102 as being anticipated by Cunningham.

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a)

In amended claim 1, we have added the features of former claim 8, namely, that the surface of the at least one ablation or mapping electrode is coated at least partially with elementary platinum.

Cunningham describes an ablation electrode which is made from platinum (column 6, line 62/63). However, Cunningham does not describe an electrode which is coated with platinum. This is an important distinction. Coating with platinum smooths the surface of the electrode by filling up small cavities. A coated electrode has a much smoother, flatter surface than a solid platinum electrode. Due to the smoother surface, electric potential differences are reduced.

Given the Amendment of claim 1 with the features of claim 8, Applicant respectfully believes that the current Amendment of the claims overcomes the "102" rejection.

Rejection Under 35 USC 103

Claims 26 and 28 are rejected under 35 USC 103 as being unpatentable over Cunningham in view of Eggers.

Applicant respectfully believes that, given the current Amendment to the claims, the present invention is not only new, but also, novel. Therefore, Applicant respectfully believes that the current Amendment to the claims overcome the “103” rejection.

The Claims

Claims 1, 2, 4 and 6-31 are pending.

Claims 10-25 are allowable.

Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Claim 27 has been thus amended.

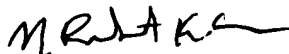
Amended claim 27 comprises the features of former claims 26 and 27. Claims 8, 26 and 29 to 31 are cancelled.

Claim 28 was not specifically addressed in the Office Action. Claim 28, which previously depended upon claim 26 (now cancelled), is amended to include the features of claim 27. Claim 28 should now be allowable.

Since the subject matter of amended claim 1 is not only new, but also, inventive, Applicant respectfully requests further consideration and allowance of the claims.

A three-month extension of time in which to respond to the outstanding Office Action is hereby requested. Credit Card Payment Form PTO-2038 is enclosed to cover the prescribed Small Entity three-month extension fee of \$510.

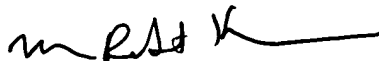
Respectfully submitted,



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I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 25, 2005.



M. Robert Kestenbaum